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THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : **Confirmation No. 7425**
Peter HEROLD et al. : Attorney Docket No. 2006_0446A
Serial No. 10/574,108 : Group Art Unit 1624
Filed March 31, 2006 : Examiner Kahsay Habte
ORGANIC COMPOUNDS : **Mail Stop: Amendment**

RESPONSE TO REQUIREMENT FOR RESTRICTION
AND ELECTION OF SPECIES

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

THE COMMISSIONER IS AUTHORIZED
TO CHARGE ANY DEFICIENCY IN THE
FEE FOR THIS PAPER TO DEPOSIT
ACCOUNT NO. 23-0975.

Sir:

Responsive to the Office Action of September 19, 2008, constituting a requirement for restriction, Applicants hereby elect the subject matter of Group (A) as defined on page 2 of the Office Action, where R¹ is a heterocyclycl group.

The Examiner has also required an election of species, in response to which Applicants elect the compound of Example 5 beginning on page 26 of the specification, i.e. 6-(4-{4-[3-(2-Methoxy-benzyloxy)-propoxy]-phenyl}-piperidin-3-yloxymethyl)-4-(3-methoxy-propyl)-3,4-dihydro-2H-benzo[1,4]oxazin, which falls under "dihydro-2H-benzo[1,4]oxazinyll" bridging lines 4 and 5 under the definition of Group (A) on page 2 of the Office Action.

With regard to formula (I) in claim 11, in the compound of Example 5:

Q is absent,

R³ and R⁴ are hydrogen,

m is 0 and thus W is absent,

X is oxygen,

Z is C₁-alkylene,

n is 1, and

R² is phenyl, substituted by an L1-T1-L2-T2-L3-T3-L4-T4-L5-T5-U radical, whereby

L1 is absent,

T1 = (g) = -O-,

L2 = C₃-alkylene,

T2 = (g) = -O-,

L3 = C₁-alkylene,

T3 = (f) = -CR⁷R⁸ with R⁷ and R⁸ together with the C-atom to which they are bonded are a 6-membered ring,

L4 = absent,

T4 = (g) = -O-,

L5 = absent,

T5 = absent, and

U = C₁-alkyl.

The compound of Example 5 is encompassed by the following claims:

11, variant (A) with regard to R¹ as shown,

12, stereochemistry according to formula (Ia),

13, as those groups shown for claim 11 reappear in claim 13,

14, as “3,4-dihydro-2H-benzo[1,4]oxazin” falls under “3,4-dihydro-2H-benzo[1,4]oxazinyl” in line 2 of claim 14 in the definition of R¹,

15, as R² is phenyl substituted by “C₁-alkoxybenzyloxy-C₃-alkoxy” in line 2 of claim 15,

16, as X is oxygen,

17, as Z is methylene, and finally claims 19 to 22.

In summary, claims 11-17 and 19-22 read on the elected species.

The foregoing elections are made with traverse, based on the following considerations.

Initially, reference is made to the Written Opinion of the PCT-Searching Authority, where the Search actually was based on the claims as originally filed and not on the instantly filed amended set of claims. Furthermore, the PCT-Search Report indicated that novelty destroying prior art compounds fall (only) under variant (B) (see Written Opinion, item V, point 1.1) for the original set of claims.

Also please note that although an indication was made that a non-unity objection might be raised in subsequent Examination procedures in case lack of novelty is indeed found (see Written Opinion, item V, point 2.3), which would lead to a set of claims lacking a single inventive concept, it is up to the instant Examiner to prove that novelty destroying prior art exists for the instant set of claims which would allow a non-unity objection.

A complete Search was nevertheless carried out under the PCT. It is thus not acceptable that the instant Examiner raises objections based merely on an examination and search burden, while otherwise no arguments are provided why different groups R¹ would lead to “mutually exclusive characteristics”.


In a regular U.S. utility (non-PCT) application, a different conclusion might be reached concerning whether or not a restriction requirement is appropriate. However, in accordance with PCT Articles 27(1) and 27(4), the Offices must form their views based on the criteria set out in PCT Rule 13, unless the result of alternative national criteria is more favorable to the applicant. As the latter approach is obviously not the case, the Examiner should clearly follow PCT Rule 13.

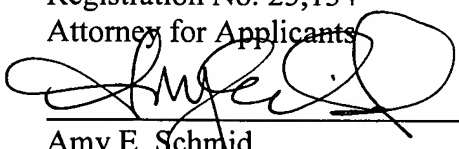
For these reasons, Applicants take the position that the restriction requirement and requirement for election of species should be withdrawn.

Action on the merits is requested.

Respectfully submitted,

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